REMARKS

FORMAL MATTERS

Petition for Extension of Time

The applicant herein (the "Applicant") hereby petitions pursuant to 37 C.F.R. § 1.136(a) for a one month extension of time to respond.

Fees and Authorization to Charge

A check for appropriate fees under 37 C.F.R. §§ 1.16(b) & 1.17(a)(1) are enclosed herewith. Authorization is hereby granted to charge Deposit Account No. 501273 for any additional fees associated with this filing. A separate paper authorizing charging of the deposit account is enclosed.

Summary of the Amendment

New claims 17-22 have been added to define the invention better.

A paragraph describing Figure 9 has been added at the end of the *Brief Description of the Drawings* section. The paragraph does not constitute new matter because "selection of Advanced options" appears on the face of Figure 9 as a number of options and corresponding checkboxes under the selected "Advanced" tab. The fact that Figure 9 represents a configuration window is

apparent from the similarity of Figure 9 to Figures 6-8, and the characterization of these Figures throughout the specification and, in particular, on page 7, lines 16-22.

SUBSTANTIVE MATTERS

Summary of the Office Action

In the Office Action, the honorable Examiner rejected claims 1, 2, 5-7, 9-13, and 16 of the Application under 35 U.S.C. § 102(a) as being anticipated by U.S. Patent No. 5,991,276 to Yamamoto ("Yamamoto"). The Examiner also rejected claims 3, 4, 8, 14, and 15 under 35 U.S.C. § 103(a) as unpatentable over Yamamoto in view of what is allegedly well known in the art. The Applicant respectfully disagrees and traverses the rejections for reasons explained below.

Yamamoto Does Not Anticipate Independent Claims 1, 7, and 12

Axiomatically, a "claim is anticipated if each and every limitation is found either expressly or inherently in a single prior art reference." *Celeritas Technologies, Ltd. v. Rockwell Int'l Corp.*, 150 F.3d 1354, 1361, 47 U.S.P.Q.2d 1516 (Fed. Cir. 1998). "The identical invention must be shown in as complete detail as is contained in the patent claim." *Richardson v. Suzuki Motor Corp.*, 868 F.2d 1226, 1236, 9 U.S.P.Q.2d 1913, 1920

(Fed. Cir. 1989); *see also* MANUAL OF PATENT EXAMINING PROCEDURE § 2131 (7th ed., 1st rev. Feb. 2000) ("MPEP § ___" hereinafter). Because Yamamoto does not disclose an "identical invention" having "each and every limitation" of the claims of the Application, Yamamoto does not anticipate the claims.

The Examiner's rationale for rejecting the claims was as follows:

> As to claims 1-2, and 5-6, Yamamoto shows in Figs 1-3, 11-13, 15, a computer system including a first computer 2a, a control site computer 3a, and a second computer 2b are coupled together through a computer network I. Yamamoto teaches a first computer 2a would select a region on its display to be transmitted to a control site 3a and thereafter being transmitted by the control site computer 3a to a second computer 2b to be displayed on its display, see col 1, lines 64-67, col 2, lines 1-7, col 3, lines 1-11, lines 44-56, col 7, lines 36-67, col 8, lines 20-63, col 11, lines 23-45, lines 64-67, col 12, lines 1-46, col 13, lines 40-51.
>
> As to claims 7, 9-13, and 16, the claims are similar in scope to claims 1-2, and 5-6, and they are rejected under the same rationale.

Office Action at 3-4. The Applicant's attorney has carefully reviewed the Yamamoto reference, including the portions cited by the Examiner, but has not found any teaching of "a selector for selecting a region on the first display," as recited in claim 1 at line 4; teaching of program instructions for "selecting the region on the first computer," as recited in claim 7 at line 4;

or teaching of "means for selecting the region [from the display of the first computer]," as recited in claim 12 at lines 1-3.

Although Yamamoto possibly describes transmitting video signals from video conference participants, the transmitted signals originate from video cameras of the video conference terminals. For example, Yamamoto writes that "[i]n FIG. 2, user terminals 6a-6d are videoconference terminals equipped with a video camera [sic]." Yamamoto at col. 3, lines 60-62 ("col. 3:60-62"). Yamamoto then teaches the details of the video information exchange during a video conference thus:

> FIG. 14 is a sequence diagram showing a procedure of information transmission and reception which is performed by a videoconference server and user terminals while a videoconference is in session. The following will explain the operations performed in this procedure, in accordance with the sequence numbers shown in FIG. 14.
>
> [S41] Using the MPEG video encoder 23, the user terminal 6a connected to the videoconference server 9a encodes the video data captured with the video camera 15 and sends the compressed data to the videoconference server 9a through the connection path ch-A.

Yamamoto at col. 11:17-27. Other visual information exchanged in Yamamoto's system includes information captured by peripheral devices attached to the personal computers used as platforms for the user terminals. *Id.* at col. 3:64-65; col. 5:41-43. "The peripheral devices include: a keyboard 13, a mouse 14, a video

camera 15, an image scanner 16, a microphone 17, a speaker 18, and a video display unit 19." *Id.* at col. 5:43-45.

Note that Yamamoto's mouse is not used to select any portion of the screen, but rather "mouse 14 is used to point at a particular position of a document image shown on the screen of the video display unit 19." *Id.* at col. 5:49-51. On the receiving end, "a mouse position data receiver 32 generates some symbol images to represent the original mouse positions sent from the user terminals." *Id.* at col. 6:24-26. Thus, mouse position data are exchanged between the user video conference terminals; the mouse position data is not related to objects on the display. In sum, Yamamoto does not teach the use of mouse, or anything else, as a device for selecting display regions for subsequent transmission of the region's image to another computer.

Yamamoto does teach a video data combiner, which performs as follows:

> From each data, the video data combiner 50 cuts out a portrait picture with an adequate size which includes at least the face of a participant. Here, the video frame is partitioned into macroblocks each consisting of 16×16 pixels, and the portrait picture extraction is actually restricted by the boundaries of this partition. The video data combiner 50 arranges the extracted pictures adequately on the same screen, thereby creating a combined video signal.

Id. at col. 7:56-63. The video combiner, however, simply "cuts out a portrait picture with an adequate size"; there is no teaching of the video combiner with the ability to select the cut out portion. Moreover, the video data combiner operates on the video stream provided by a video camera, not on the image within a selected region of the display of the transmitting computer. *See id.* at col. 5:53-55. And the "cutting out" takes place at the videoconference servers. *Id.* at col. 7:14-19. But the Examiner analogized a videoconference server to "a control site computer." Office Action at page 2, last paragraph. Thus, according to the logic of the rejection, with which we do not necessarily agree, the video data combiner is part of the control site computer; it is not part of the first computer or of the first computer's display.

Failing to teach "a selector for selecting a region on the first display," Yamamoto is incapable of teaching most of the other elements of the independent claims because the elements operate on the image associated with the selected region. For example, in claim 1, the *first transmitter* is "for transmitting an image associated with said region." Claim 1, lines 5-6. But in Yamamoto's system, the transmitter in a user terminal cannot transmit an image of a region that has never been selected. The

same logic applies to the *second transmitter*, claim 1 at lines 7-8, which is "for transmitting said image"; and to the *display*, claim 1 at lines 9-10, which is "for displaying the image." Note that independent claims 7 and 12 include similar limitations.

Because of these alternative and independent reasons, the Applicant respectfully requests the Examiner to reconsider and withdraw the rejection of independent claims 1, 7, and 12, as well as the rejection of the claims that depend therefrom.

Yamamoto Does Not Anticipate Claims 2, 5, 6, 9-11, 13, and 16

The Examiner rejected these claims together with the independent claims, as discussed under the immediately preceding subheading. Not one of the additional limitations of these claims has been addressed. The claims, however, do add limitation. For example:

1. Claim 2 recites the selector using "a combination of keystrokes to capture the image of said region on said first display."

2. Claim 5 recites the selector that "automatically refreshes said region and retransmits said region." Note that the sole mention of retransmitting in Yamamoto expressly requires the user to click on the "transmit" button. Yamamoto at

col. 7:10-13. Therefore, Yamamoto may teach manual -- but not automatic -- retransmission.

3. Claim 6 recites subsequent transmission of "only the changes in said region," i.e., incremental updating.

Claims 9, 11, 13, and 16 similarly add limitations that have not been considered by the Examiner and that cannot be found in Yamamoto.

Claims 2, 5, 6, 9-11, 13, and 16 are patentable over Yamamoto.

Claims 3, 4, 8, 14, and 15 Would Not Have Been Obvious in View of Yamamoto

The Patent and Trademark Office ("PTO") has the initial burden of making a *prima facie* case of obviousness. *E.g., In re Mayne*, 104 F.3d 1339, 1342 (Fed. Cir. 1997); MPEP § 2142. For a *prima facie* case of obviousness to arise, the prior art must teach or suggest all elements of the claim. *In re Mayne*, 104 F.3d at 1341 (citing *Graham v. John Deere Co.*, 383 U.S. 1, 17-18 (1966)); MPEP § 2143. Further, the prior art must suggest the combination or method claimed and reveal a reasonable expectation of success. *In re Vaeck*, 947 F.2d 488, 493 (Fed. Cir. 1991); MPEP § 2143. "Both the suggestion and the reasonable expectation of success must be founded in the prior

art, not in the applicant's disclosure." *In re Vaeck*, 947 F.2d at 493.

In the instant case, the Examiner rejected claims 3, 4, 8, 14, and 15 as follows:

> Yamamoto does not use the Internet as a medium to transfer the data . . . . The use of the Internet to establish a conference was well known in the art. Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the system of Yamamoto to be implemented using the Internet in order to enable remote computers to collaborate at large distances.

Office Action at page 3. We respectfully disagree with the statement that the use of the Internet for conferencing was well known at the relevant time. But even if it were so, the rationale for combining Yamamoto with the Internet is still lacking. Enabling "remote computers to collaborate at large distances" is not the exclusive domain of the Internet. ATM systems are known to span large distances, including intercontinental distances. Consider, for example, the following statement:

> Simon Bernstein, Principal Member of Technical Staff for GlobalOne said that extensive trials of intercontinental ATM links have produced very favorable results and he sees Sprint, France Telecom and Deutsche Telekom as firmly committed to an eventual worldwide deployment of ATM.

3 MADGE ATM NEWS DIGEST 218 (Nov. 15, 1996) (*as available at* http://www.atmdigest.com/archive96/v3n218.txt). The Examiner

can also take administrative notice of a description of the Multimedia Applications on Intercontinental-Highway (MAI) project *available at* http://mats.gmd.de/kaul/english/MAI.htm. The goal of the "MAI project is . . . to test emerging communication facilities between research and industrial sites in Germany and the United States of America. The communication makes use of advanced multimedia collaboration tools like BERKOM and MBONE over an *intercontinental ATM link*." *Id.*, first paragraph (emphasis provided).

There is simply no suggestion in Yamamoto or other art of record that ATM is somehow deficient in enabling remote computer communication, or that Internet is superior in enabling such communication. Therefore, the art of record does not teach or suggest a combination of Yamamoto's system with the Internet, and no *prima facie* case of obviousness has been made.

As regards the additional limitations found in claims 4, 8, and 14, the Office Action is completely silent. As regards claim 4, it depends from dependent claim 3 and adds this limitation: "the selected region is converted into an image file format before transmission to the control site computer." But Yamamoto apparently mentions transmission of graphic files only in the context of data inputted from peripheral devices, e.g., from a scanner or a video camera; Yamamoto does not teach or

suggest generating graphic files from a selected region of the display. *See, e.g.*, Yamamoto at col. 5:14-17; *id.* at col. 5:41-63.

As regards claims 8 and 14, they recite composing a URL (e.g., address of a file), sending the URL to the second computer, receiving a request for the URL, and transmitting the image associated with the selected region of the first computer's display to the second computer. This is more limiting than simply using the Internet for coupling the computers, and Yamamoto is utterly devoid of a corresponding teaching.

Therefore, no *prima facie* case of obviousness of claims 3, 4, 8, 14, and 15 has been made.

CONCLUSION

The Yamamoto reference neither anticipates nor renders obvious the claims of the Application. We respectfully submit that the Application is in condition for allowance and solicit an early notice to that effect.

Respectfully submitted,

BROBECK, PHLEGER & HARRISON LLP

Dated: 7-19-01

By: _____
Franklin D. Ubell
Reg. No. 27,009

BROBECK, PHLEGER & HARRISON LLP
12390 El Camino Real
San Diego, CA 92130-2081
Telephone: (858) 720-2500
Facsimile: (858) 720-2555